UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2156	

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒   Responsive to communication(s) filed on <u>25 September 2002</u> .

2a)☐   This action is **FINAL**.   2b)☒   This action is non-final.

3)☐   Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒   Claim(s) <u>11-29,37-44</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐   Claim(s) _____ is/are allowed.

6)☒   Claim(s) <u>11 - 29, 37 - 44</u> is/are rejected.

7)☐   Claim(s) _____ is/are objected to.

8)☐   Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐   The specification is objected to by the Examiner.

10)☐   The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐   The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐   The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐   Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐   Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐   Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 11 – 29, 37 – 44 are presented for examination.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
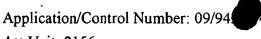
2. Claims 18 – 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The use of the phrase "notifying instructions" on page 24 is vague and indifferent. Please give a more detailed description of the meaning of these words in your specification.
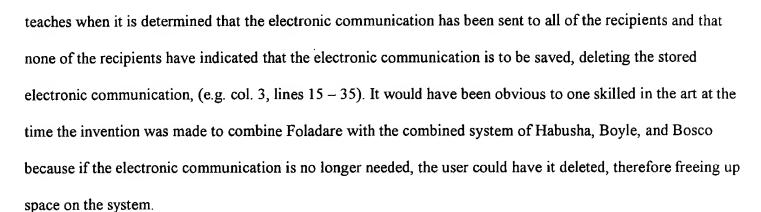
Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 11 – 13, 17, 23, 24, 37 – 39, 41 - 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Habusha et al. U.S. Patent No. 6205498 (hereinafter Habusha) in view of Boyle et al. (6119167) (hereinafter Boyle) in further view of Bosco (6335963).

5.   As per claim 11, Habusha teaches a computer-implemented method for sending an electronic

communication to recipients, the method comprising:

6.   receiving an indication of an electronic communication and of at least one recipient to receive the

electronic communication, (e.g. col. 1, lines 26 – 56);

7.   when it is determined that multiple recipients have been indicated, storing the electronic communication,

(e.g. col. 5, line 44 – col. 6, line 11);

8.   in response to a request for the electronic communication from a recipient, sending the electronic

communication to the recipient, (e.g. col. 6, lines 27 – 40). Habusha does not specifically teach determining

whether multiple recipients of the electronic communication have been indicated; and

9.   notifying each of the multiple recipients of the electronic to communication without sending the

electronic communication to the recipients. Boyle teaches determining whether multiple recipients of the

electronic communication have been indicated, (e.g. col. 25, line 41 – col. 26, line 34). It would have been

obvious to one skilled in the art at the time the invention was made to combine Boyle with Habusha because if

there were no way to find determine if multiple recipients have been indicated the system could continue to

send the electronic communication, which could lead to error and excess traffic on a network. Bosco teaches

notifying each of the multiple recipients of the electronic to communication without sending the electronic

communication to the recipients, (e.g. col. 1, lines 39 – 60). It would have been obvious to one skilled in the art

at the time the invention was made to combine Bosco with the combined system of Habusha and Boyle because

it could lead to excess information being stored on a system and excess information being transferred on a

network, making for a slow response.

10.   As per claim 12, Habusha teaches when it is determined that multiple recipients have not been indicated,

sending the electronic communication to the recipient without waiting for a request for the electronic

communication, (e.g. col. 6, lines 27 – 40).

11.   As per claim 13, Habusha teaches tracking the sending of the electronic communication to the

recipients, (e.g. col. 5, line 44 – col. 6, line 11); and

12.   when the electronic communication has been sent to all of the recipients, deleting the stored electronic

communication, (e.g. col. 5, line 44 – col. 6, line 11).

13.   As per claim 17, Habusha and Bosco do not specifically teach wherein the notifying of a recipient of the

electronic communication involves sending a distinct indicator electronic communication to the recipient. Boyle

teaches wherein the notifying of a recipient of the electronic communication involves sending a distinct

indicator electronic communication to the recipient, (e.g. col. 7, lines 1 – 21). It would have been obvious to one

skilled in the art at the time the invention was made to combine Boyle with the combined system of Habusha

and Bosco because if there is a distinct electronic communication that has important data in it there would be a

needed for the user to know that that distinct electronic communication is different from other electronic

communications, therefore giving it the specific attention that it could need.

14.   Claims 23, 24, 37 – 39, 41 - 43 are rejected for similar reasons as stated above.

15.   Claims 14, 15, 25, 40, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Habusha

(6205498) in view of Boyle (6119167) in further view of Bosco (6335963) in further view of Foladare et al.

(6311210) (hereinafter Foladare).

16.   As per claim 14, Habusha, Boyle, and Bosco do not specifically teach when it is determined that the

electronic communication has been sent to all of the recipients and that none of the recipients have indicated

that the electronic communication is to be saved, deleting the stored electronic communication. Foladare

teaches when it is determined that the electronic communication has been sent to all of the recipients and that none of the recipients have indicated that the electronic communication is to be saved, deleting the stored electronic communication, (e.g. col. 3, lines 15 – 35). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Habusha, Boyle, and Bosco because if the electronic communication is no longer needed, the user could have it deleted, therefore freeing up space on the system.

17.   As per claim 15, Habusha, Boyle, and Bosco do not specifically teach when it is determined that the electronic communication has been sent to all of the recipients and that all of the recipients have indicated that the electronic communication can be deleted, deleting the stored electronic communication. Foladare teaches when it is determined that the electronic communication has been sent to all of the recipients and that all of the recipients have indicated that the electronic communication can be deleted, deleting the stored electronic communication, (e.g. col. 3, line 55 – col. 4, line 15). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Habusha, Boyle, and Bosco because in case a user makes the mistake of deleting information or is unsure if the information selected for deletion is correct, the system would have to have permission to delete the information. This could be used in a form of error checking.

18.   Claims 25, 40, 44 are rejected for similar reasons as stated above.

19.   Claims 16, 18, 19, 21, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Habusha (6205498) in view of Boyle (6119167) in further view of Bosco (6335963) in further view of Alumbaugh et al. (6442592) (hereinafter Alumbaugh).

20.   As per claim 16, Habusha, Boyle, and Bosco do not specifically teach determining a period of time for

which the electronic communication will be stored; and

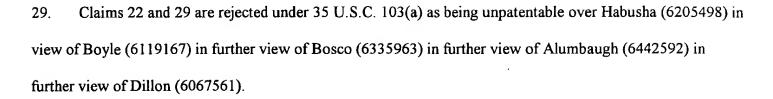21.   when the determined period of time has expired, deleting the stored electronic communication.

Alumbaugh teaches determining a period of time for which the electronic communication will be stored, (e.g.

col. 9, lines 21 – 43); and

22.   when the determined period of time has expired, deleting the stored electronic communication, (e.g. col.

9, lines 21 – 43). It would have been obvious to one skilled in the art at the time the invention was made to

combine Alumbaugh with the combined system of Habusha, Boyle, and Bosco because if a user has information

that is forgotten for a period of time, the system could delete this information, therefore freeing up space in

memory.

23.   As per claim 18, Habusha, Boyle, and Bosco do not specifically teach including retrieving notifying

instructions for a recipient, and wherein the notifying of the recipient is performed according to the notifying

instructions. Alumbaugh teaches including retrieving notifying instructions for a recipient, and wherein the

notifying of the recipient is performed according to the notifying instructions, (e.g. col. 9, lines 21 – 43). It

would have been obvious to one skilled in the art at the time the invention was made to combine Alumbaugh

with the combined system of Habusha, Boyle, and Bosco because if a specific electronic communication

information is received the notifying instruction could perform a function on that information that would be

different from other electronic communications that are received.

24.   As per claim 19, Habusha, Boyle, and Bosco do not specifically teach wherein the notifying instructions

are supplied by a sender of the electronic communication. Alumbaugh teaches wherein the notifying

instructions are supplied by a sender of the electronic communication, (e.g. col. 9, lines 21 – 43). It would have

been obvious to one skilled in the art at the time the invention was made to combine Alumbaugh with the

combined system of Habusha, Boyle, and Bosco because if the sender needed to send the electronic

communication to a specific location it could do so without the user having take time to do it them selves.

25.   As per claim 21, Alumbaugh does not specifically teach wherein the notifying instructions are

determined automatically based on past interactions with the recipient. Boyle teaches wherein the notifying

instructions are determined automatically based on past interactions with the recipient, (e.g. col. 7, lines 33 –

36). It would have been obvious to one skilled in the art at the time the invention was made to combine Boyle

with Alumbaugh because it is a more efficient way to have a electronic communication dealt with, therefore

saving time on the users side.

26.   Claims 27 and 28 are rejected for similar reasons as stated above.

27.   Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Habusha (6205498) in view of

Boyle (6119167) in further view of Bosco (6335963) in further view of Alumbaugh (6442592) in further view

of Wang et al. (6314454) (hereinafter Wang).

28.   As per claim 20, Alumbaugh does not specifically teach wherein the notifying instructions are supplied

by the recipient. Wang teaches wherein the notifying instructions are supplied by the recipient, (e.g. col. 4, lines

5 – 21). It would have been obvious to one skilled in the art at the time the invention was made to combine

Wang with Alumbaugh because if the recipient receives the electronic communications and wants the sender to

perform an action on the electronic communication, (i.e. delete it), the receiver could send a notification

instruction to the sender. Therefore, having the sender perform actions that a receiver may not be able to

perform.

29.   Claims 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Habusha (6205498) in view of Boyle (6119167) in further view of Bosco (6335963) in further view of Alumbaugh (6442592) in further view of Dillon (6067561).

30.   As per claim 22, Alumbaugh does not specifically teach wherein the notifying instructions indicate that the notifying is to be performed in an encrypted manner. Dillon teaches wherein the notifying instructions indicate that the notifying is to be performed in an encrypted manner, (e.g. col. 9, line 60 – col. 10, line 14). It would have been obvious to one skilled in the art at the time the invention was made to combine Dillon with Alumbaugh because it would provide for secure transmission for private information.

31.   Claim 29 is rejected for similar reasons as stated above.

32.   Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Habusha (6205498) in view of Boyle (6119167) in further view of Bosco (6335963) in further view of Landfield et al. (5632011) (hereinafter Landfield).

33.   As per claim 26, Habusha, Boyle, and Bosco do not specifically teach automatically sending the electronic communication to a non-recipient authorized to access the electronic communication. Landfield teaches automatically sending the electronic communication to a non-recipient authorized to access the electronic communication, (e.g. col. 6, lines 60 – 67). It would have been obvious to one skilled in the art at the time the invention was made to combine Landfield with the combined system of Habusha, Boyle, and Bosco because if there is electronic communication data that would have information that is dangerous to the system an non-recipient authorized to access the electronic communication, (i.e. administrator), could check it for harmful information that could damage the system.

34.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

35.   a.   Benner et al. U.S. Patent No. 5931915 discloses Method for processing early arrival messages within a multinode asynchronous data communications system.

36.   b.   Hogan et al. U.S. Patent No. 5646982 discloses System and method for message delivery.

37.   c.   Block et al. U.S. Patent No. 6192417 discloses Multicast cluster servicer for communication amongst a plurality of nodes without a dedicated local area network.

38.   d.   Helfman et al. U.S. Patent No. 6396513 discloses Electronic message sorting and notification system.

39.   e.   Quinn U.S. Patent No. 5944786 discloses Automatic notification of receipt of electronic mail (E-mail) via telephone system without requiring log-on to E-mail server.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alvin Oberley can be reached on 703-305-9761. The fax phone numbers for the organization where this application or proceeding is assigned are none for regular communications and none for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England
Examiner
Art Unit 2156

De
September 25, 2002

JOHN A. FOLLANSBEE
PRIMARY EXAMINER